UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LINDA V. GRAVELL, JEFFREY D. PIERCE, LEON A. PINTSOV, JOHN G. RAHRIG and DAVID W. RILEY

Appeal No. 2005-1854
Application No. 09/242,210[1]

ON BRIEF

Before DIXON, BLANKENSHIP and SAADAT, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1 and 9-18, which are all of the claims remained pending in this application.

We affirm-in-part.

BACKGROUND

[1] Application for patent filed November 4, 1999, which is filed under 35 U.S.C. § 371 of Application No. PCT/US98/12081, filed June 12, 1998 which claims the filing priority benefit under 35 U.S.C. § 119 of Provisional Application No. 60/049,518, filed June 13, 1997.

BACKGROUND

Appellants' invention is directed to a virtual postage metering system that provides central management of all postage without the need for managing physical meters. An understanding of the invention can be derived from a reading of exemplary independent claims 1 and 9, which are reproduced as follows:

> 1. A method for evidencing postage on a mailpiece comprising the steps of:
>
> receiving at a data center postal information relating to a mailpiece, said postal information including recipient address information for the mailpiece;
>
> generating a digital token for the mailpiece, said digital token including encrypted information for the mailpiece based on said recipient address information;
>
> creating a transaction record, said transaction record including the digital token and the postal information;
>
> signing the transaction record;
>
> storing the transaction record in a database at the data center; and
>
> performing value added services using the transaction record.

> 9. A system for dispensing postage value comprising:
>
> a data center communicatively coupled to a remote processor via a network, a user initiating a request to the data center via the remote processor to dispense postage value to be printed by a printer coupled to the remote processor, the data center comprising:

a storage device to store data records, the data records including a user account and a meter account associated with the user;

a first cryptographic module coupled to the storage device, the first cryptographic module including a first key to decrypt a user authentication key included in the user account, the user authentication key being used to authenticate the user; and

a second cryptographic module coupled to the storage device, the second cryptographic module including a second key to decrypt a token key included in the meter account, the token key used to generate a digital token, the second cryptographic module further including a third key used to sign a transaction record associated with generating the digital token, the signed transaction record being stored in the storage device;

wherein the data center sends the digital token to the remote processor via the network.

The Examiner relies on the following prior art references:

Kara	5,822,739	Oct. 13, 1998 (filed Oct. 2, 1996)
Whitehouse	6,005,945	Dec. 21, 1999 (filed Mar. 20, 1997)

Claim 1 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Kara.

Claims 9-18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Whitehouse.

Claims 9-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Whitehouse.

Rather than reiterate the opposing arguments, reference is made to the briefs and answer for the respective positions of Appellants and the Examiner. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the briefs have not been considered (37 CFR § 41.37(c)(1)(vii)).

OPINION

Appellants argue that Kara provides no teaching related to the claimed signing a transaction and storing the transaction record in a database (brief, page 5). In particular, Appellants argue that the "unique transaction identifier" included in the data packet of Kara, which provides no protection against alteration of the transaction record, is different from a digital signature which authenticates and protects the integrity of the information (brief, page 6; reply brief, page 1). Referring to Figure 3 of Kara, Appellants point out that the generated data packet is sent to the demanding site for use in printing the postage indicia and therefore, is not relevant to creating a transaction record, signing the record and storing the signed transaction record (brief, paragraph bridging pages 6-7).

In response to Appellants' arguments, the Examiner asserts that claim 1 does not recite a "digital signature" or require the

protective functions described by Appellants as being offered by a digital signature (answer, page 6). The Examiner further argues that the "data packet" generated by Kara is a transaction record created by including information related to the transaction which is also taught (col. 12, lines 15-25) to be stored for fraud protection purposes (id.).

A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). See also Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999).

We observe that Kara relates to a system and method for remote postage metering of postage indicia (abstract; col. 1, lines 7-15). As depicted in Figure 3, a meter program validates a demand and the funding for the postage indicia before a data packet is generated to represent the desired postage indicia (col. 14, lines 30-34). The information encompassed by the data packet includes data and amount of postage as well as a unique transaction identifier (col. 14, lines 34-38). We also note that the unique transaction identifier, as asserted by the Examiner, is stored and used in detection of postage fraud by determining

whether a transaction number already generated is used again for creating a postage indicia (col. 12, lines 26-35).

Based on the analysis above, we note that a determination of the issues on appeal before us turns on whether the claimed "signing the transaction record" reads on the unique transaction identifier of Kara. In other words, we must begin with a determination of the scope of the claim which must then be compared with the teachings of Kara in order to determine whether the claims are patentable over the prior art reference. Claim interpretation must begin with the language of the claim itself. See SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). As such, in determining the scope of claim 1, "We recognize that there is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification." Comark Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1186, 48 USPQ2d 1001, 1005 (Fed. Cir. 1998). In locating this "fine line" it is useful to remember that we look "to the specification to ascertain the meaning of the claim term as it is used by the inventor in the context of the entirety of his invention," and not merely to limit a claim term. Id. at 1187, 48 USPQ2d at 1005.

Relying on the words of the claim and based on the principles outlined above, we find that the term "signing the transaction record" generally relates to an attribute that is the evidence of postage payment and verification such as a token or digital signature (specification, page 8, lines 15-21). Although the specification mentions "digital signature" for verifying the record, claim 1 recites creating a transaction record which includes a digital token. Therefore, we remain unconvinced by Appellants' arguments (brief, page 6) that the step of "signing the transaction record" does necessarily require a "digital signature" as the verification tool. We also agree with the Examiner (answer, page 6) that Kara stores the unique transaction number in the verification process and the detection of fraud (col. 12, lines 15-35) which indicates that generating the "unique transaction identifier" in the data packet has reasonably been equated with the claimed signing the record. Accordingly, the 35 U.S.C. § 102(e) rejection of claim 1 over Kara is sustained.

With respect to the rejection of claims 9-18, the Examiner characterizes the validation procedure elements 161 and the encryption keys 164 of Whitehouse (Figure 4; col. 8, lines 34-41) as the claimed first and second cryptographic modules,

respectively (answer, page 4). Alternatively, the Examiner points out that although Whitehouse does not explicitly disclose "the use and locations of the first, second, third and fourth keys," employing any number of keys as needed would have been obvious to one of ordinary skill in the art since it requires mere duplication of the essential parts (answer, page 5).

Appellants argue that although the reference uses digital signature, the data representing the postage indicium with the signature is encrypted before it is transmitted to the user (brief, page 10). Appellants add that Whitehouse stores the meter balance on computer media rather than secure meter registers and concludes that the data stored in Whitehouse is not secured (brief, page 10).

Initially, after reviewing the relevant portions of Whitehouse, we cannot agree with the examiner that the validation procedure 161 and encryption keys 164, included in the validation procedure 161, can be properly equated with the first and the second cryptographic modules. The validation process 161 includes the encryption keys 164 (col. 8, lines 30-42) and at the best, together may represent the first module.

Additionally, the Examiner's reasoning that because the reference mentions the use of a key encryption method, one of

ordinary skill in the art would have been motivated to employ any number of keys ignores the claimed requirement for the location of each key. Although Whitehouse discloses public and private keys used in the encryption/decryption process, the examiner's line of reasoning places these keys in the encryption keys 164 which is a part of the first module or the validation procedure 161.

Lastly, we agree with Appellants' argument with respect to the absence of signing a transaction record associated with generating the digital token and storing the signed record. Whitehouse teaches that the postage indicium except for a digital signature is generated (col. 13, lines 16-17) and with the digital signature is encrypted and transmitted to the user (col. 13, lines 46-50). However, the Examiner has not pointed to any teachings in Whitehouse indicating that the stored record includes a signature generated using the third key, as recited in claim 9. Additionally, as pointed out by Appellants (reply brief, page 2), a transaction record reflecting the generated postage indicium does not appear to need signature since it is stored in a database in the secure central computer (col. 13, lines 50-54).

In view of the discussion above, we find that Whitehouse does not teach all of the claimed features and cannot anticipate the claims. Additionally, the Examiner has not pointed to any convincing rationale in modifying Whitehouse in order to overcome the deficiencies of the reference discussed above. Accordingly, we do not sustain the rejection of claims 9-18 neither as anticipated under 35 U.S.C. § 102, nor as obvious under 35 U.S.C. § 103 over Whitehouse.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claim 1 under 35 U.S.C. § 102 is affirmed, but is reversed with respect to rejecting claims 9-18 under 35 U.S.C. §§ 102 and 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

JOSEPH L. DIXON
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

MAHSHID D. SAADAT
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

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